



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/374,989	08/16/99	MATAMA	T 1982-0129P

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BIRCH STEWART KOLASCH & BIRCH
8110 GATEHOUSE ROAD
SUITE 500 EAST
FALLS CHURCH, VA 22042

EXAMINER

WALKE, A

ART UNIT	PAPER NUMBER
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1752

DATE MAILED:

12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application N .

09/374989

Applicant(s)

Matama

Examiner

A. Wallace

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/12/2000
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 and 5 is/are rejected.
- ☒ Claim(s) 4 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasper et al (5,919,730) in view of Orengo et al (6,020,115).

Gasper et al disclose a copy restrictive material comprising a reflective or transmissive support having coated thereon at least one light sensitive image forming layer, and a pattern of visually undetectable, but machine detectable, microdots positioned between the support and the light sensitive layer (column 3, line 13- column 4, line 5, column 6, line 5 - column 7, line 48). A suggested means of incorporating the microdot pattern into the material is to laminate the material using a transparent overlay containing the microdots. The microdots may be made of materials such as colorants commonly used as dyes, solid particle dyes, pigments, inks, and toners. These colorants may be transparent, translucent, or opaque, and may modulate light by any means including refraction, scattering, or emission of light. Both color and black and white image forming photographic materials are useful in the present invention (column 9, line 54- column 10, line 6). In column 9, the reference states that the photographic media suitable for use in the practice of the invention is a silver halide photographic material. The silver halide photographic

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material preferably contains at least one but preferably more radiation sensitive emulsion layers sensitive to a region of the spectrum extending from the ultraviolet to the infrared specifically the red, green, and blue regions. The specific order and additives may be any known in the art. The microdots may be printed onto the support of the material prior to the addition of the emulsion layers (column 10, lines 7-50). It is the position of the examiner that the pattern of visually undetectable, but machine detectable, microdots positioned between the support and the light sensitive layer of the Gasper et al reference is an identification code as it identifies the material and inhibits it from being copied.

Orengo et al disclose a multilayer silver halide photographic material having on a support blue, green, and red sensitive emulsion layer units containing yellow, magenta, and cyan dye-forming couplers respectively (column 12, lines 11-49). The most sensitive layer of each emulsion layer unit has a weight ratio of the coupler to the silver halide which is lower than or equal to that of the medium sensitive layer and much lower than that of the low sensitive layer. In other words, the layer of highest sensitivity of the emulsion layer unit is "starved" of dye-forming coupler. The couplers used in the green sensitive layers are 2-equivalent 5-pyrazolone magenta couplers which worsen the interimage effect (column 4, lines 38-68). An improvement in the interimage effect may be achieved by making higher the coupler/ silver ratio in the highest sensitive layer of the green emulsion layer unit. Other than the dye-forming couplers, the emulsion layers may contain masking couplers and DIR couplers (column 13 line 56- column 14,

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line 45 and column 23 lines 59-68 also see example 1). The support of the material may be a cellulose ester support, paper support, or a polyester film support (column 24, lines 48-54).

It would have been obvious to one of ordinary skill in the art to prepare a copy restrictive document as taught by Gasper et al choosing to use the known silver halide photographic material of Orengo et al which has an interimage effect, contains masking couplers, and DIR couplers, with reasonable expectation for achieving a copy restrictive photographic material having non-visible, but machine detectable microdots of high quality and utility.

3. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or suggest to one of ordinary skill in the art to prepare a material having one or none of a color correcting function in which the identification code is recorded onto the cartridge accommodating the photographic material.

4. Applicant's arguments filed 10/12/2000 have been fully considered but they are not persuasive.

Applicant has argued that neither reference discloses an identification code that records information. The examiner believes that the microdots disclosed by Gasper et al do record some information. The information contained in the microdots prevents the material from being copied.

Also, the material of Orengo et al teaches that an improvement in the interimage effect may be achieved by making higher the coupler/ silver ratio in the highest sensitive layer of the

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green emulsion layer unit, and that other than the dye-forming couplers, the emulsion layers may contain masking couplers and DIR couplers. The examiner maintains her position that it would have been obvious to one of ordinary skill in the art to prepare the material of Gasper et al in view of Orengo et al and choose to change the coupler/ silver ratio to improve the interimage effect, add a masking coupler, or add a DIR coupler with reasonable expectation for achieving a copy restrictive photographic material having non-visible, but machine detectable microdots of high quality and utility.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Walke whose telephone number is (703) 305-0407. The examiner

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can normally be reached on Monday- Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


acw

December 4, 2000

HOA VAN LE
PRIMARY EXAMINER

